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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204603
Party	Plaintiff Bombardier Recreational Products Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Bombardier Recreational Products Inc.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91204603
v.	)	
	)	Ser. No. 79097186
Mirza Juddani,	)	
	)	
Applicant.	)	

**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS  
COUNTERCLAIM UNDER FRCP 12(b)(6)**

In response to the motion to dismiss the counterclaim for failure to state a claim, Applicant, Mirza Juddani, asserts that the motion to dismiss should be denied because Opposer’s home country registration did not include “tour guide services and travel agency services, namely, making reservations and bookings for transportation; tour guide services” which are included in Reg. No. 3673043 and classified in International Class 39.

Applicant attempts to distinguish the cases cited by Opposer in its brief, including *Phonak Holding*, on the grounds that Opposer did not own a registration that included the specific wording of the services that Applicant seeks to cancel from Reg. No. 3673043. While the Board in *Phonak Holding* distinguished situations where an applicant did not own a foreign registration which could serve as a basis, under Section 44(e), for issuance of the U.S. registration, this situation does not apply in this case. When it perfected its Section 44(e) basis on March 23, 2009, Registrant owned Canadian registration no. TMA176452 which issued on

February 24, 2009 and, in fact, submitted a copy of the registration certificate for its Canadian registration to the US PTO. Like the United States application, the Canadian registration no.

TMA176452 included a wide range of goods and services, namely:

Snowmobiles and parts therefor; Antifreezes and fuel stabilizers for snowmobiles; chemical motor oil additives and chemical fuel additives for snowmobiles; Degreasers for use on snowmobiles; Industrial oils and greases; lubricants; fuels and illuminants; fuel stabilizers; Differential oil; First-aid kits; safety kits for vehicles, namely: ropes, whistles, aluminum blankets, flashlights and pins; Metal objects, namely: die-cast models, key-chain trinkets and fobs; license plates; metal stools; Vehicle jacks; Pocket knives; shovels and snow-shovels; Protective snowmobile jackets; protective snowmobile boots; protective snowmobile pants; pre-recorded digital versatile discs, pre-recorded compact discs and pre-recorded video cassettes all featuring snowmobiles and related parts and accessories; diagnostic software for snowmobiles; magnetically encoded cards, namely: credit cards; reflective arm bands; eye-glasses; eye-glass cases; sunglasses cases; protective knee pads; electronic and electromechanical keys and locks and key fobs; mouse pads; avalanche probes; karabiner with multi-function electronic display; video game cartridges; ski goggles; Tachometers; speedometers; Protective snowmobile helmets; protective snowmobile goggles; protective snowmobile suits; sunglasses; protective kidney belts; Batteries for vehicles; Lamps; flashlights; Fitted and semi-fitted snowmobile trailer covers; snowmobile accessories, namely: mud flaps, fender trim, a-arm protectors, shock absorber protectors; vehicle lifts; skid plates; headlight molding rear vent kits; windshields; cargo nets and tie-down cords; protectors attachable to vehicle handlebars to protect hands from the cold; protective coverings for handlebars; handlebar muffs; seat covers; Fitted and semi-fitted snowmobile covers; Rear and front bumpers; backrests; combination seat and gas tank; snow guards; Fine and imitation jewelry, namely: pins; clocks; watches; watch cases; Paper goods, namely: magazines, brochures, catalogs, manuals, technical publications (shop manuals, parts catalogues, owner's manuals); technical plans, charts, drawings, user manuals, posters, calendars, flags, maps and pennants, loose-leaf binders, bumper stickers, stickers, pens, pencils, pen and pencil sets, gift wrapping paper, greeting cards; tattoo transfers; Decals, labels, banners; Bags and cases, namely: tote bags, sports bags, traveling bags, duffel bags, luggage, suitcases, suit bags, trunks, carrying cases, hand bags, helmet bags, trunk bags, saddlebags, snowmobile tunnel bags, vehicle tank bags; back packs; Plastic objects, namely: plastic key-chain trinkets; Articles for cleaning purposes, glassware, porcelain and earthenware, namely: travel mugs, glasses; Mugs; Clothing, wearing apparel and accessories, namely: shirts, sweatshirts, t-shirts, pullovers, sweatpants, jeans, shorts, boxer shorts, bermudas, nightshirts, coats, wind resistant jackets, vests, dresses, skirts, blouses, underwear, belts, scarves, gloves, mittens; footwear, namely: boots, sandals; headgear, namely: visors: snow-sportswear, namely: highpants, pants, jackets, dickeys, balaclavas, masks, boots, racing suits, wrist bands; Snow-sportswear, namely snow-pants, mitts, gloves; sweaters; footwear namely: snow boots; headgear, namely: hats, caps, tuques; footwear, namely: snow shoes, socks; thermal underwear; jerseys; snowmobile

suits; jackets; pants; Men's, ladies, boys and girls snowsuits, all-weather jackets and ski-jackets; Zipper pulls; Toys, namely: miniaturized snowmobiles; christmas ornaments; sleds; snow tubes; playing cards; foam toys; balls of all sizes and shapes; inflatable ride-on toys; Radio controlled model snowmobiles; Balloons; Non-chemical motor oil additives and non-chemical fuel additives for snowmobiles; candles; Metal objects, namely: key holders; tool-boxes; license plate frames; metallic signs; metal mechanical keys, locks and key fobs; collapsible vehicle garages (metal); Tools and multi-purpose knives; hand tools and sets thereof; pocket multi-tool units; Data processing equipment and computers; video game software; electronically encoded cards, namely: credit cards and telephone cards; neon signs; whistles; fire extinguishers; electronic greeting cards; hand-held GPS devices; Snowmobile trailers; snowmobile accessories, namely: rock deflectors, splash guards; trailer hitches; removable vehicle tops; tire covers; tires; vehicle windshield sunscreens; vehicle sun shades; Plastic materials for packaging; cardboard; photographs; paper goods, namely: litographs, diaries, agendas, gift wrapping bags, books; non-magnetically encoded cards; coupons; Bags and cases, namely: wallets, gym bags; leaches and collars; insulated bags; Plastic objects, namely: non-metal tool boxes; plastic key-chain trinkets and fobs; plastic key holders; portable fuel containers; non-metal storage racks for ski and sports equipment; stools; mirrors; Articles for cleaning purposes, glassware, porcelain and earthenware, namely: cups; All-purpose straps; lanyards for holding eyeglasses; unfitted vehicle covers; clothing, wearing apparel and accessories, namely: raincoats; footwear, namely: shoes; headgear, namely: headbands, rain hats, snow-sportwear, aprons, bandanas; overalls; jump-suits; Mats and matting, vehicle floor mats; Gymnastic and sporting articles; toys, namely: 3-D puzzles; snowboards; tobaggans; three-skis; inflatable snow toys; snowmobile footstepper toys; Business management; business administration; advertising and cooperative advertising for others by means of airing television advertisements, radio advertisements, placing news paper advertisements, circulating brochures, posters, banners, and providing information via the Internet and selling of snowmobiles and snowmobile parts, snowmobile accessories, snowmobile clothing and snowmobile equipment; arranging and conducting trade shows and exhibitions in the field of snowmobiles; operating dealerships trading in snowmobiles, and parts, accessories, clothing and equipment therefor; providing trade information via a global computer network in the field of snowmobiles; on-line retail store services for snowmobiles and parts, accessories, clothing and equipment therefor; mail order catalog services featuring snowmobiles and parts, accessories, clothing and equipment therefor; Sponsoring races of snowmobiles and sponsoring snowmobile racers and snowmobile racing teams; providing financial services, namely: issuing credit cards; Repairing, servicing and restoring snowmobiles for others; Distributing, renting and leasing snowmobiles for others; Manufacturing and custom manufacturing snowmobiles for others; Organizing and providing educational courses in respect of snowmobiles, snowmobile servicing and repairing and snowmobile restoration; organizing snowmobile races, competitions, events, clubs and contests; Designing snowmobiles for others.


To rely on its home country registration as the basis for registration under Section 44(e), an Applicant must meet the requirements listed in TMEP Section 1004. Among those requirements, “the scope of the goods covered by the §44(e) basis cannot exceed the scope of the goods or services in the foreign registration”. *See also* TMEP Section 1012. There is no requirement that the US application include the exact wording that is set forth in the foreign registration. Instead, there is some ambiguity and the Examining Attorney has discretion to assess whether the description of goods and/or services is within the “scope” of the description of the goods and services in a home country registration. Applicant’s counterclaim, therefore, essentially asks the Board to second guess the Examining Attorney’s *ex parte* determination that the services in the US application are within the scope of the services identified in the Canadian registration relied upon by Opposer. Thus, just as with the adequacy of specimens of use discussed in *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989) were not a proper basis for an opposition, the adequacy of the Canadian registration in encompassing the services set forth in Opposer’s registration is solely a matter of *ex parte* examination, and that a proper ground for partial cancellation. The proper claim would instead be one of abandonment, and Applicant does not allege abandonment in its counterclaim.

Respectfully submitted,

BOMBARDIER RECREATIONAL PRODUCTS INC.

Date: August 8, 2012

By:

  
James R. Menker

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing “**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS COUNTERCLAIM UNDER FRCP 12(b)(6)**” has been served on Applicant’s Attorney of record, Paul I. Perlman of HODGSON RUSS LLP, with an address of 140 Pearl St., Suite 100, The Guaranty Building, Buffalo, NY 14202, via first class mail, today **August 8, 2012**.

By:   
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Laura K Greer